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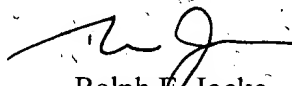
Re: **Application Serial No.:** 09/776,503
Confirmation No.: 9612
Applicants: Dale Blackson, et al.
Title: System and Method for Dispensing
Digital Information from an Automated
Transaction Machine
Docket No.: D-1132 R

Sir:

Appellants request reinstatement of their appeal pursuant to 37 C.F.R. § 1.193(b)(2). Please find enclosed both a Notice of Appeal and a Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192 in triplicate, in response to the Action dated March 30, 2004 for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with these filings and any other fee due to Deposit Account 09-0428.

Very truly yours,


Ralph E. Jocke
Reg. No. 31,029

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D-1132 R

GROUP 3600

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of)	
Dale Blackson, et al.)	
)	
Serial No.: 09/776,503)	Art Unit 3624
)	
Confirmation No.: 9612)	
)	
Filed: February 2, 2001)	Patent Examiner
)	Hani M. Kazimi
Title: System and Method for)	
Dispensing Digital Information)	
from an Automated Transaction)	
Machine)	

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Commissioner for Patents
PO Box 1450
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**SUPPLEMENTAL BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby request reinstatement of their appeal pursuant to 37 C.F.R. § 1.193(b)(2). The Appellants hereby submit their Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192, in triplicate, concerning the above-referenced Application. No fee is deemed required.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this matter.

STATUS OF CLAIMS

Claims 1-86 are pending in the Application.

Claims 1-86 were rejected under 35 U.S.C. § 112, second paragraph, as failing to specifically claim what Appellants regard as their invention.

Claims 1-86 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over De Leo, et al. (US 6,381,626) (hereinafter "De Leo") in view of Monteiro, et al. (US 5,778,187) (hereinafter "Monteiro") and further in view of Duliege (US 6,477,532).

These rejections were the only rejections present in the Office Action ("Action") dated March 30, 2004. Appellants appeal the rejections of claims 1-86, inclusive.

STATUS OF AMENDMENTS

No final rejection is pending. Prosecution was reopened in response to Appellants' Appeal Brief filed January 7, 2004. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

Appellants acknowledge the Office's admission by implication that previously appealed rejections have been withdrawn because of arguments presented in Appellants' previously filed Appeal Brief. That is, the Office has admitted that the claims are patentably distinguishable over "De Leo in view of Monteiro" which was the basis for the previous 35 U.S.C. § 103(a) rejection of claims 1-86. As shown in more detail herein, Appellants' claims are also allowable over the pending new grounds of rejection (which additionally relies on Duliege). Thus, Appellants respectfully request reinstatement of their appeal pursuant to 37 C.F.R. § 1.193(b)(2).

Furthermore, in light of the Office's reopening of prosecution after the filing of an Appeal Brief, Appellants reserve the right to further expound on the issues and address the rejections after an Examiner's Answer has actually been written. That is, until the drifting cloud of prosecution rejections and reopenings has passed, it would be unreasonable (and an undue burden) to expect Appellants to explain the issues in fine detail. Appellants will address the arguments presented in the Examiner's Answer in their Reply Brief. Nevertheless, Appellants provide sufficient reasons herein why the pending claims are allowable.

SUMMARY OF INVENTION

Overview of an exemplary form of the Invention

An exemplary form of the invention is directed to a cash-dispensing automated teller machine (ATM) that can also dispense digital content (e.g., a digital music file) to a user of the ATM. Using music as an example of dispensed digital content, the ATM can place a song on a portable storage medium (e.g., a user supplied CD) or function as a jukebox and play the song through the ATM's sound system. The ATM also permits payment for the song to be debited from the ATM user's bank account. The multi-purpose ATM can be conveniently located in a restaurant or bar to generate user fees from both the dispensing of cash and the dispensing of music.

The ATM (10) includes an input device (16), an output device (18), and a cash dispenser (24). The ATM can read account information from a card with a card reader (20) and validate a user PIN input through the input device. The ATM can dispense requested cash through operation of the cash dispenser (24). The ATM can also dispense digital content through an output device (18) responsive to user input selections. The account associated with the card can be debited for the value of cash dispensed and the digital information dispensed. Digital content dispensed by the ATM can include sound recordings such as MP3 files, video files, and digital books. The sound files (e.g., songs) can be acquired by the ATM from a remote digital information source via the Internet. The ATM can either play a downloaded song through an ATM sound system or send the song to a portable storage medium. The ATM also can cause a licensing fee associated with each digital content dispense to be transferred to an account of the licensing entity.

CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are:

- 1). Whether Appellants' claims 1-86 are unpatentable under 35 U.S.C. § 112, second paragraph, as failing to specifically claim what Appellants regard as their invention.
- 2). Whether Appellants' claims 1-86 are unpatentable under 35 U.S.C. § 103(a) over De Leo in view of Monteiro and further in view of Duliege.

GROUPING OF CLAIMS

No groups of claims stand or fall together. Reasons are provided in the Argument section herein. The arguments presented hereafter provide reasons why each of the claims is separately patentable. Appellants present for each respective separate claim a corresponding respective separate argument as to why the claim is patentable over the rejection applied thereto. Reasons are provided how each claim recites additional features of the invention which distinguishes the claim over every other pending claim. Reasons are further provided how each of the claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes each claim. All pending claims 1-86 are reproduced in the Appendix.

ARGUMENT

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142 (Eighth Edition, August 2001; Rev. 1, Feb. 2003).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The De Leo Reference

De Leo is directed to providing a non-transaction message (i.e., an advertisement; col. 6, lines 53-54) to a user during ATM processing of a transaction (e.g., dispensing cash). De Leo desires that operation of the ATM (18) be coordinated with the advertisement presentation. This coordination gives the user the impression that the operating ATM (which the user can hear) is working (to dispense cash) on their behalf. De Leo reasons that because the user can hear the cash dispenser operating (i.e., hear the ATM working) during the advertisement, the user will have a positive disposition toward the advertisement. Likewise, De Leo is concerned that presenting an advertisement prior to approval of the user's requested transaction (which leads to hearable operation of the ATM) may cause a negative impression with the user. That is, presenting an advertisement (alone) without coordination with ATM operation may result in the user having a negative disposition toward the advertisement. Particularly note De Leo at col. 7, line 47 to col. 8, line 20, and the Abstract.

The Monteiro Reference

Monteiro is directed to a providing audio and/or visual communication services, in real-time to a multiplicity of identifiable users on a communications network, such as the

Internet. A scalable architecture is disclosed for delivery of real-time information over the communications network. Embedded into the architecture is a control mechanism that provides for the management and administration of users who are to receive the real-time information. In the preferred embodiment, the information being delivered is high-quality audio. Preferably, there are multiple (radio) channels of information available simultaneously to be delivered to users, with each channel consisting of an independent (audio) stream of information. A user chooses to tune in or tune out a particular channel, but does not choose the time at which the channel distributes its information. The system uses paid advertisements. The system has a network control center (10), primary servers (20), media servers (30), users (40), control servers (50), and an administration server (60).

The Duliege Reference

Duliege is directed to a process for publishing musical scores (i.e., a written piece of music) available for online purchase. A music score is downloadable as an image file (col. 1, lines 66-67; col. 2, lines 38-39; col. 6, line 41). A downloaded image file is unusable on any machine other than that of the buyer (col. 2, lines 42-43). The downloaded image file also has means to limit its number of printings (col. 1, line 67; col. 2, lines 43-46; col. 6, line 42).

(ii) 35 U.S.C. § 112, Second Paragraph

Claims 1-82 have been rejected under 35 U.S.C. § 112, second paragraph, as failing to specifically claim what Appellants regard as their invention. The Appellants respectfully traverse the rejections.

The Action is silent as to how the claims fail to recite what Appellants regard as their invention. Appellants respectfully decline to speculate as to how the claims do not set forth the subject matter that Appellants regard as their invention. A rejection based on the failure to satisfy this requirement of 35 U.S.C. § 112, second paragraph, is appropriate only where the Appellants have stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims (MPEP § 2172). The Office has provided no evidence that shows that a claim does not correspond in scope with that which Appellants regard as their invention. The Appellants are claiming subject matter that they regard as their invention.

The Office alleges that the independent claims are vague. Appellants respectfully disagree, especially in light of the absence of any evidentiary example of vagueness. Appellants respectfully decline to speculate how the independent claims are vague. Contrarily, it is the unsupported rejection that is vague.

In conclusion, the claims meet the requirements of 35 U.S.C. § 112, second paragraph. Thus, it is respectfully submitted that the 35 U.S.C. § 112, second paragraph, rejections should be withdrawn.

(iii) 35 U.S.C. § 103

The Action procedurally fails to establish a *prima facie* case of obviousness.

The Action is silent as to what constitutes each of the recited features and relationships in the relied upon references. The Action fails to provide Appellants with an element by element analysis of each claim, and an indication of where the elements (or steps) in each claim are found

in the applied art. The Action does not state in any way that is reasonably understandable by Appellants, where the specific features recited in Applicants' claims 1-86 are allegedly found in the applied art. Appellants refuse to speculate which portions (if any) of the rejection body correspond with which claims. The Action's uncorrelated jumbled blanket rejection of all claims appears to intentionally obscure the real issues. For these reasons it is respectfully submitted that the Action procedurally fails to establish a *prima facie* case of obviousness, and the rejections should be withdrawn.

The Office has not properly conducted a *Graham v. John Deere Co.* analysis in the consideration and determination of obviousness under 35 U.S.C. § 103. For example, the Action fails to ascertain the differences between the prior art and each of the 86 claims in issue. It follows that the Action has not met the basic criteria for establishing a *prima facie* case of obviousness. That is, the Action has procedurally failed to establish a *prima facie* case of obviousness. Nor do the relied upon references teach or suggest the recited features and relationships. The record lacks substantial evidence support. *In re Zurko*, supra. The Office bears the burden of factually supporting a *prima facie* conclusion of obviousness. If the Office does not produce a *prima facie* case (which is the current situation), then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142 (Eighth Edition, August 2001; Rev. 1, Feb. 2003).

Appellants respectfully submit that the Office's silence concerning all of the recited features and relationships, its disregard for the analysis required by *Graham v. John Deere Co.*, and the lack of substantial evidence support in the record, are reflective of the impropriety of all the rejections in the Action from which this appeal was taken.

Also, the Action's blanket rejection (which is part of a reopening of prosecution after an Appeal Brief) consist of a mere 17 sentences for the 86 pending claims. There is no evidence of record that all 86 pending claims were even considered, let alone examined.

Appellants traverse the rejections.

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features and relationships recited in Appellants' claims patentably distinguish over the applied references.

Appellants respectfully submit that none of the applied references, taken alone or in combination, teach or suggest the features and relationships that are specifically recited in the claims. The Office has not established a *prima facie* showing of obviousness. Additionally, even if it were somehow possible for the references to have disclosed certain features as alleged, it still would not have been obvious to one having ordinary skill in the art to have combined the references as alleged. Furthermore, even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not have produced Appellants' claimed invention. That is, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention. Thus, Appellants respectfully submit the rejections are improper and should be withdrawn.

**The Pending Claims Are Not Obvious Over
De Leo in view of Monteiro and further in view of Duliege**

Claims 1-86 were rejected under 35 U.S.C. § 103(a) as being unpatentable over De Leo in view of Monteiro and further in view of Duliege. These rejections are respectfully traversed.

Claim 1

None of De Leo or Monteiro or Duliege, taken alone or in combination, teach or suggest the recited features and relationships. Where do the references teach or suggest the capability of both dispensing currency responsive to a first user input and dispensing a digital information file responsive to a second user input? The references do not teach or suggest an automated transaction machine apparatus that provides a user thereof the ability to cause a currency dispense responsive to a first input and cause a digital information file dispense responsive to a second input, especially where the second input "corresponds" to the digital information file.

De Leo is directed to providing a non-transaction message (i.e., advertisement; col. 6, lines 53-54) to a user during ATM operation (e.g., dispensing cash). That is, De Leo desires that operation of the ATM be coordinated with the advertisement presentation. This coordination gives the user the impression that the operating ATM (which the user can hear) is working (to dispense cash) on their behalf. De Leo reasons that because the user can hear the cash dispenser operating (i.e., hear the ATM working) during the advertisement, the user will have a positive disposition toward the advertisement. Likewise, De Leo is concerned that presenting an advertisement prior to approval of the user's requested transaction (which leads to operation of the ATM) may cause a negative impression with the user. That is, presenting an advertisement (too soon) without coordination with ATM operation may result in the user having a negative

disposition toward the advertisement. Particularly note De Leo at col. 7, line 47 to col. 8, line 20, and the Abstract.

Where does De Leo teach or suggest a second user input? De Leo does not teach or suggest the dispense of a digital information file in response to user (second) input. In De Leo a non-transaction message is displayed in response to transaction approval by the host (col. 2, lines 9-15; col. 8, lines 18-21; Figure 4). Where does De Leo teach or suggest that a non-transaction message is displayed in response to user input, especially where the (second) input differs from another (first) input, and where the (second) input "corresponds" to a digital information file?

Where does De Leo teach or suggest a (second) user input (being different from a first input) that results in an advertisement presentation? Where does De Leo teach or suggest that a non-transaction message is displayed in response to a digital information file dispense (second) user input instead of a cash dispense transaction (first) user input? The only input provided by a user in De Leo is transaction data input for a requested transaction (e.g., cash dispense transaction). After all of this transaction data has been entered by the user, then the transaction approval request containing the user entered data (regarding the requested transaction) is sent to the host (col. 7, lines 5-21, particularly lines 18-21). After the transaction is approved by the host, then a signal is sent to the terminal causing the display of a non-transaction message (col. 7, lines 47-50). A user in De Leo does not provide a separate (second) input that corresponds to the dispense of a digital information file. Exactly where does De Leo provide an (second) input (different than the transaction data (first) input) that causes a digital information file to be dispensed?

De Leo specifically teaches that it is not preferable to display a non-transaction message prior to transaction approval (col. 2, lines 12-13; col. 8, lines 18-20). Nevertheless, even if a message were displayed prior to transaction approval, it would still be displayed after all user transaction inputs were completed (col. 8, lines 14-16). Thus, De Leo does not teach or suggest an arrangement in which a user can provide a first input to cause currency dispensing and can provide a second input to cause digital information file dispensing. The activities in De Leo occur after user input has been completed. The activities (e.g., cash dispensing and advertising) in De Leo are (at best) responsive to the same user input. Appellants respectfully disagree with the Action's assertion (at page 3, lines 4-5) that De Leo's "digital file outputs and currency transactions are not necessarily coupled." De Leo's cash dispensing and advertising are coupled in many ways. For example, they are coupled via common (first) input, which further enables them to be coupled in coordinated timing.

Furthermore, De Leo's user inputs are (at best) directed to a terminal transaction, e.g., cash dispensing. Where does De Leo teach or suggest a user input (i.e., the second user input) that corresponds to a digital information file? Where does De Leo teach or suggest that a (second) user input corresponding to a digital information file, causes the dispense of the digital information file through an output device of the machine? De Leo does not teach or suggest a cash dispensing automated transaction machine apparatus that enables both the dispense of currency responsive to first input and the dispense of a digital information file responsive to second input.

Monteiro cannot alleviate the deficiencies in De Leo as it does not teach or suggest the recited features and relationships not found in De Leo. Monteiro is directed to multicasting using

a communications network such as the Internet. Monteiro is non analogous art. For example, Monteiro is not directed to dispensing currency. Monteiro does not teach or suggest dispensing cash at col. 2, lines 1-24 as alleged (Action page 3). Nor does Monteiro even mention "cash" or "currency." It follows that Monteiro does not teach or suggest a cash dispensing automated transaction machine apparatus that enables a user to dispense currency. Monteiro also does not teach or suggest a user input that corresponds to a digital information file, especially where the user input is a second input. The Action (at page 3, line 13) relies on Monteiro at col. 17, lines 5-35 for allegedly having a digital information file output in hard copy form. The Action's relied upon digital information file in Monteiro is actually a CD (col. 17, lines 29-30) that is apparently mailed to the user. Claim 1 recites an automated transaction machine apparatus comprising at least one output device and "dispense of at least one of the digital information files through the at least one output device." Where is it taught or suggested that Monteiro's CD dispensed through an output device of an automated transaction machine, especially a cash-dispensing automated transaction machine? It isn't. It follows that Monteiro (like De Leo) does not teach or suggest a cash dispensing automated transaction machine apparatus that enables a user to both dispense currency responsive to first input and dispense a digital information file responsive to second input.

Duliege cannot alleviate the deficiencies in the teachings of De Leo/Monteiro as it does not teach or suggest the recited features and relationships not found in De Leo/Monteiro. Duliege does not teach online purchases of audio files as the Action alleges at col. 3, line 24 to col. 4, line 5, or anywhere else. Duliege is directed to the publishing of musical scores (i.e., a written piece of music). Duliege teaches having a music score downloadable as an image file

(col. 1, lines 66-67; col. 2, lines 38-39; col. 6, line 41). Furthermore, a downloaded image file is only usable on the machine of the buyer (col. 2, lines 42-43) and further has means to limit its number of printings (col. 1, line 67; col. 2, lines 43-46; col. 6, line 42). Duliege's image file is not compatible with Monteiro's audio.

Duliege is non analogous art. For example, Duliege is not directed to dispensing currency. Where does Duliege teach or suggest a cash dispensing automated transaction machine apparatus that enables a user to dispense currency? Duliege (like Monteiro) also does not teach or suggest the ability to provide a first input to cause currency dispensing. It follows that Duliege (like De Leo and Monteiro) does not teach or suggest a cash dispensing automated transaction machine apparatus that enables a user to both dispense currency responsive to first input *and* dispense a digital information file responsive to second input.

Furthermore, even if it were somehow possible for Monteiro and Duliege to have disclosed certain features as alleged, it still would not have been obvious to have modified De Leo as alleged. For example, as previously discussed, Duliege's downloaded image file is only usable on the machine of the buyer. It would not have been obvious to one having ordinary skill in the art to pay for a file (of Duliege) that one can only use at a (busy) ATM machine (of De Leo).

Nor does the Action explain how De Leo could be structurally and functionally modified as alleged, especially to overcome the deficiencies therein. There is no evidence that the ATM of De Leo is structurally and functionally capable of receiving Monteiro's Internet radio or downloading Duliege's image file from the Internet (or printing Duliege's image file). Monteiro and Duliege rely on the Internet. Where does De Leo teach or suggest an ATM on the Internet?

Contrarily, De Leo teaches away from using the Internet. De Leo teaches that ATMs typically communicate with their host utilizing a dedicated land line (col. 4, lines 9-12). Proprietary lines are typically used for reasons of security. It would not have been obvious to one having ordinary skill in the art to have modified De Leo's secure proprietary line form of host/ATM communication in the manner alleged in the Action. Furthermore, the alleged modification to De Leo would destroy the specifically disclosed utility and operability of the De Leo apparatus. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Also, since the Action does not explain the rejections with reasonable specificity (e.g., by not explaining how De Leo could be modified), it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

Additionally, even if it were somehow possible (which it isn't) to have modified De Leo as alleged this would still not render the resultant combination obvious because the prior art does not suggest the desirability of the modification (MPEP § 2143.01). The Action is devoid of any teaching, suggestion, or motivation for modifying De Leo to have produced the recited invention. Nor does De Leo have any need of modification.

There is no common link between De Leo's host-controlled ATM video advertising (at no cost to the user), Monteiro's Internet radio, and Duliege's written music image file. The Action has not provided any legally reasonable motivation for combining the dissimilar teachings. The only suggestion for the recited features and relationships of claim 1 is found in Appellants' own novel disclosure. It follows that the alleged modification of De Leo in view of Monteiro and

Duliege is based on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992).

Furthermore, even if it were somehow possible (which it isn't) for the references to be modified as alleged, the resultant combination still would not have produced Appellants' recited invention. That is, the above noted deficiencies in each of De Leo, Monteiro, and Duliege would still remain. For example, even if it were somehow possible (which it isn't) for the references to be combined as alleged, the result still would not teach or suggest both dispensing currency responsive to a first user input *and* dispensing a digital information file responsive to a second user input.

The record lacks substantial evidence support. *In re Zurko*, supra. Nor does the Action factually support any *prima facie* conclusion of obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. As previously discussed, the Office has not met this burden. If the Office does not produce a *prima facie* case, which is the current situation, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). None of the references, taken alone or in combination, disclose or suggest the recited features and relationships. It follows that it would not have been obvious to one having ordinary skill in the art to have modified the references as alleged to have produced the recited apparatus of claim 1. Thus, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 2

Claim 2 depends from claim 1. The references, taken alone or in combination, further do not teach or suggest a card reader device to read account indicia from a card, where one or more fees can be charged to the read account corresponding to a currency dispense and a digital information file dispense. Nor has the Office established *prima facie* obviousness.

Claim 3

Claim 3 depends from claim 1. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine apparatus with the ability to dispense currency responsive to a first user input *and* dispense a digital sound recording file responsive to a second user input. The Office has not established a *prima facie* showing of obviousness.

Claim 4

Claim 4 depends from claim 3. The references, taken alone or in combination, further do not teach or suggest the ability to both dispense currency responsive to a first user input and dispense an MP3 file responsive to a second user input. It follows that it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited apparatus.

Claim 5

Claim 5 depends from claim 3. The references, taken alone or in combination, further do not teach or suggest the ability to dispense a digital sound recording file responsive to user input, and output sound through a sound system responsive to the digital file. The Office has not established a *prima facie* showing of obviousness.

Claim 6

Claim 6 depends from claim 1. The Action is silent with regard to a licensing fee associated with a digital information file. Nevertheless, the combined references do not teach or suggest an automated transaction machine apparatus that can transfer a licensing fee associated with a digital information file to a licensing entity. Again, the Office has not established a *prima facie* showing of obviousness. The Action's assertion of obviousness is not based on any evidence in the record. *In re Zurko*, supra. *In re Lee*, supra.

Claim 7

Note Appellants' remarks in support of the patentability of claim 1. None of De Leo or Monteiro or Duliege, taken alone or in combination, disclose or suggest the recited features and relationships. None of the references, taken alone or in combination, disclose or suggest an automated transaction machine that includes both a cash dispenser that can deliver cash responsive to input to an input device of the machine and an output device that can cause the delivery of digital content responsive to input of a digital content delivery fee authorization to an input device of the machine.

It would not have been obvious to one having ordinary skill in the art to have modified De Leo with the teaching of Monteiro and Duliege to have produced the recited apparatus. The combined references do not teach or suggest charging a fee for delivery of digital content with regard to an automated transaction machine that is capable of delivering cash. The combined references do not teach or suggest an automated transaction machine capable of causing the delivery of both cash (via a cash dispenser) and digital content (via fee authorization). Where do the combined references teach or suggest delivering digital content responsive to the inputting of

delivery fee authorization at an automated transaction machine? The combined references do not teach or suggest the ability to provide a fee authorizing input at an automated transaction machine for delivery of digital content. Where do the combined references teach or suggest a cash-dispensing automated transaction machine having an input device that can receive fee authorization for delivery of digital content, and an output device that can cause the delivery of the digital content responsive to the authorization? The combined references do not teach or suggest the recited relationship between at least one input device and at least one output device of an automated transaction machine, especially with regard to delivery of digital content and fee authorization therefor.

As previously discussed (e.g., claim 1 remarks), Monteiro and Duliege are non analogous art. As previously discussed (e.g., claim 1 remarks), there is no common link between De Leo's host-controlled ATM video advertising (at no cost to the user), Monteiro's Internet radio, and Duliege's written music image file. The Office has not presented any reasonable motivation for modifying the teaching of De Leo with the disparate teachings of Monteiro and Duliege in the manner alleged. The alleged modification of De Leo in view of Monteiro and Duliege is based only on impermissible hindsight reconstruction of Appellants' claimed invention. As previously discussed (e.g., claim 1 remarks), the Action also does not explain how De Leo could be structurally and functionally modified as alleged. De Leo is not structurally and functionally capable of receiving Monteiro's Internet radio or downloading Duliege's image file from the Internet. De Leo teaches away from using the Internet by utilizing a dedicated land line (col. 4, lines 9-12). It would not have been obvious to one having ordinary skill in the art to have attempted modification of De Leo's proprietary line arrangement with Monteiro's and Duliege's

Internet arrangements as alleged. As previously discussed (e.g., claim 1 remarks), the alleged modification to De Leo's proprietary line arrangement would result in improperly destroying the specific utility or advantage taught by De Leo. *In re Fine*, supra.

De Leo does not charge a fee for the advertisement presentations. Nor would it have been obvious to have modified De Leo to charge such a fee. Nor does De Leo have any digital content delivery fee authorization input structure, especially at an automated transaction machine. Again, the alleged modification to De Leo would result in improperly destroying the specific utility or advantage taught by De Leo. *In re Fine*, supra. Monteiro's commercial radio programming, which uses paid advertisements, cannot supply the recited fee authorization features and relationships not found in De Leo. As previously discussed (e.g., claim 1 remarks), Duliege's downloaded image file is only usable on the machine of the buyer. It would not have been obvious to one having ordinary skill in the art to pay for an image file (of Duliege) that one can only use at a particular ATM (of De Leo). Nor is Duliege's image file compatible with Monteiro's audio. Again, the alleged modification of De Leo in view of Monteiro and Duliege is based only on impermissible hindsight reconstruction of Appellants' claimed invention. The Office has not established a *prima facie* showing of obviousness. One having ordinary skill in the art would not have found it obvious to have modified De Leo in view of Monteiro and Duliege as alleged, especially to have produced the recited apparatus of claim 7. Thus, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 8

Claim 8 depends from claim 7. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine output device that can cause the delivery

of digital content, and is releasibly operatively connectable to a portable computing device. The Office has not established a *prima facie* showing of obviousness.

Claim 9

Claim 9 depends from claim 8. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine output device that can cause the delivery of digital content, especially where the output device comprises a communications port releasibly operatively connectable to a portable computing device adjacent the machine. The Office has not established a *prima facie* showing of obviousness.

Claim 10

Claim 10 depends from claim 9. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine output device that can cause the delivery of a sound file, especially where the output device comprises a communications port releasibly operatively connectable to a portable computing device adjacent the machine. The Office has not established a *prima facie* showing of obviousness.

Claim 11

Claim 11 depends from claim 10. The references, taken alone or in combination, further do not teach or suggest a cash-dispensing automated transaction machine output device that can cause the delivery of a music sound file, especially where the output device comprises a communications port releasibly operatively connectable to a portable computing device adjacent the machine. The Office has not established a *prima facie* showing of obviousness.

Claim 12

Claim 12 depends from claim 9. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine output device that can cause the delivery of an audiovisual file, especially where the output device comprises a communications port releasibly operatively connectable to a portable computing device adjacent the machine. The Office has not established a *prima facie* showing of obviousness.

Claim 13

Claim 13 depends from claim 7. The references, taken alone or in combination, further do not teach or suggest a cash-dispensing automated transaction machine with the ability to have an account charged for at least one of delivered cash and digital content. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 14

Claim 14 depends from claim 13. The references, taken alone or in combination, further do not teach or suggest the recited relationship of a card reader, at least one card, input, and account. Nor has the Office established a *prima facie* showing of obviousness.

Claim 15

Claim 15 depends from claim 13. The references, taken alone or in combination, further do not teach or suggest the ability to cause a "selected portion" of digital content to be delivered responsive to at least one "selection input" corresponding to the selected portion. Even if it were somehow possible to have De Leo, Monteiro, and Duliege combined as alleged, the result still would not have produced the recited invention.

Claim 16

Claim 16 depends from claim 15. The references, taken alone or in combination, further do not teach or suggest a cash-dispensing automated transaction machine with the ability to have an account charged for at least one of delivered cash and digital content (claim 13) and the ability to have content indicia delivered through a display device of the machine. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 17

Claim 17 depends from claim 16. The references, taken alone or in combination, further do not teach or suggest a cash-dispensing automated transaction machine with the ability to have a graphic image delivered through a display device, especially responsive to fee authorization. The Office has not established a *prima facie* showing of obviousness.

Claim 18

Claim 18 depends from claim 13. The references, taken alone or in combination, further do not teach or suggest the ability to have digital content delivered from a content data store in the manner recited.

Claim 19

Claim 19 depends from claim 18. The references, taken alone or in combination, further do not teach or suggest the ability to have digital content delivered from a content data store located in the machine. The Office has not established a *prima facie* showing of obviousness.

Claim 20

Claim 20 depends from claim 18. The references, taken alone or in combination, further do not teach or suggest a network in operative connection with a cash-dispensing automated

transaction machine, and a remote computer in operative connection with the network, and a content data store (from which the digital content is delivered) in the remote computer. The Action does not factually support a *prima facie* conclusion of obviousness.

Claim 21

Claim 21 depends from claim 20. The references, taken alone or in combination, further do not teach or suggest a financial transaction computer in operative connection with a network, especially where the account can be charged through communication with the financial transaction computer through the network. The combined references do not teach or suggest the recited charging arrangement.

Claim 22

Claim 22 depends from claim 18. The references, taken alone or in combination, further do not teach or suggest the recited relationship of a network in operative connection with a cash-dispensing automated transaction machine, a machine input device being operative to receive a network delivery address, a processor that can cause digital content to be delivered through the network to the network delivery address, and a remote computer corresponding to the network delivery address being enabled to receive the digital content. The Office has not established a *prima facie* showing of obviousness.

Claim 23

Claim 23 depends from claim 19. The references, taken alone or in combination, further do not teach or suggest a network in operative connection with a cash-dispensing automated transaction machine, and a remote computer in operative connection with the network, especially

where the remote computer includes at least one remote content data store. The Office has not established a *prima facie* showing of obviousness.

Claim 24

Claim 24 depends from claim 23. The references, taken alone or in combination, further do not teach or suggest a cash-dispensing automated transaction machine with the ability to selectively deliver digital content from either a local content data store or a remote content data store responsive to input to an input device of the machine. The Action does not factually support a *prima facie* conclusion of obviousness.

Claim 25

Claim 25 depends from claim 23. The references, taken alone or in combination, further do not teach or suggest the structural ability of a cash-dispensing automated transaction machine to cause digital content in a remote content data store to be stored in a local content data store. Nor has the Office established a *prima facie* showing of obviousness.

Claim 26

Claim 26 depends from claim 25. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine processor that can (on a periodic basis) cause selected digital content in a remote content data store to be stored in a local data store. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 27

Claim 27 depends from claim 26. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine processor that can (on a periodic basis)

cause a song sound file in a remote content data store to be stored in a local data store. The Office has not established a *prima facie* showing of obviousness.

Claim 28

Claim 28 depends from claim 26. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine processor that can (on a periodic basis) cause a book sound file in a remote content data store to be stored in a local data store. Where do the references teach or suggest a sound file corresponding to a book? The Office has not established a *prima facie* showing of obviousness.

Claim 29

Claim 29 depends from claim 26. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine processor that can (on a periodic basis) cause an audiovisual movie file in a remote content data store to be stored in a local data store. Where do the references teach or suggest an audiovisual file corresponding to a movie? The Office has not established a *prima facie* showing of obviousness.

Claim 30

Claim 30 depends from claim 27. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine processor that can (on a periodic basis) cause a song sound file (and a graphic image corresponding to the song) in a remote content data store to be stored in a local data store. Where do the references teach or suggest a graphic image corresponding to a song? The Office has not established a *prima facie* showing of obviousness.

Claim 31

Claim 31 depends from claim 13. The references, taken alone or in combination, further do not teach or suggest a network in operative connection with the machine, nor a financial transaction computer in operative connection with the network, especially where a cash-dispensing automated transaction machine processor can cause an account to be charged responsive to network communication with the financial transaction computer. The Office has not established a *prima facie* showing of obviousness.

Claim 32

Claim 32 depends from claim 31. The references, taken alone or in combination, further do not teach or suggest a financial transaction computer including a source account associated with a source of digital content, especially where the source account can be credited responsive to delivery of the digital content. Where do the references teach or suggest crediting a digital content source account for digital content? The Action does not factually support a *prima facie* conclusion of obviousness.

Claim 33

Claim 33 depends from claim 31. The references, taken alone or in combination, further do not teach or suggest a financial transaction computer having a licensing account associated with a licensing entity for the digital content, especially where the licensing account can be credited responsive to delivery of the digital content. Where do the references teach or suggest crediting a licensing account for digital content? The Office has not established a *prima facie* showing of obviousness.

Claim 34

Claim 34 depends from claim 31. The combined references do not teach or suggest an automated transaction machine that includes both a cash dispenser that can deliver cash responsive to input to an input device of the machine and an output device that can cause the delivery of digital content responsive to input of a digital content delivery fee authorization to an input device of the machine. The combined references further do not teach or suggest a financial transaction computer having an account associated with a user of the machine, especially where the account can be debited responsive to either delivery of cash or delivery of digital content. Where do the references teach or suggest the ability to debit a user account for delivery of digital content? The Office has not established a *prima facie* showing of obviousness.

Claim 35

Claim 35 depends from claim 31. The references, taken alone or in combination, further do not teach or suggest the recited relationships of a financial transaction computer, content prepay account, input device, account, and delivery of the digital content. Nor do the references teach or suggest the ability of a content prepay account to be debited responsive to the delivery of digital content. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 36

Claim 36 depends from claim 31. The references, taken alone or in combination, further do not teach or suggest a cash-dispensing automated transaction machine including a reproduction device that can reproduce digital content on a portable storage medium. Where do the references discuss portable storage of digital content? The Office has not established a *prima facie* showing of obviousness.

Claim 37

Claim 37 depends from claim 36. The references, taken alone or in combination, further do not teach or suggest that a cash-dispensing automated transaction machine reproduction device can cause digital content to be reproduced in a portable computing device releasibly operatively connectable with the machine. A *prima facie* case of obviousness has not been established.

Claim 38

Claim 38 depends from claim 37. The references, taken alone or in combination, further do not teach or suggest the ability to have digital content reproduced in a portable computing device such that it can only be played in the portable computing device. The Office has not established a *prima facie* showing of obviousness.

Claim 39

Claim 39 depends from claim 37. The references, taken alone or in combination, further do not teach or suggest the ability to have digital content reproduced in a portable computing device such that it cannot be further transferred in digital form from the portable computing device. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 40

Claim 40 depends from claim 37. The references, taken alone or in combination, further do not teach or suggest the ability to have digital content reproduced in a portable computing device with limited play. The Office has not established a *prima facie* showing of obviousness.

Claim 41

Claim 41 depends from claim 37. The references, taken alone or in combination, further do not teach or suggest the ability to have digital content reproduced in a portable computing device such that it can only be played during a limited time period. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 42

Claim 42 depends from claim 36. The references, taken alone or in combination, further do not teach or suggest a cash-dispensing automated transaction machine including a supply of portable media, and a reproduction device of the machine can reproduce digital content on a portable storage media from the supply. A *prima facie* showing of obviousness has not been established.

Claim 43

Claim 43 depends from claim 8. The references, taken alone or in combination, further do not teach or suggest the ability of having digital content reproduced with restricted reproduction in a portable computing device. Where do the combined references teach or suggest restricting reproduction of digital content, especially with regard to a cash-dispensing automated transaction machine that can cause the delivery of the digital content? The Office has not established a *prima facie* showing of obviousness.

Claim 44

Claim 44 depends from claim 7. The references, taken alone or in combination, further do not teach or suggest a cash-dispensing automated transaction machine including a supply of portable storage media, where the machine can cause digital content to be reproduced on portable

storage media from the supply. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 45

Claim 45 depends from claim 31. The references, taken alone or in combination, further do not teach or suggest delivering digital content through audio outputs of a cash-dispensing automated transaction machine sound system in response to fee authorization input to the machine, especially where a machine processor can cause an account to be charged responsive to network communication with a financial transaction computer. The Action does not factually support a *prima facie* conclusion of obviousness.

Claim 46

Claim 46 depends from claim 7. The references, taken alone or in combination, further do not teach or suggest delivering digital content through audio outputs of a cash-dispensing automated transaction machine sound system, especially in response to fee authorization input to the machine. The Office has not established a *prima facie* showing of obviousness.

Claim 47

Claim 47 depends from claim 31. The references, taken alone or in combination, further do not teach or suggest delivering digital content through an audiovisual output device of a cash-dispensing automated transaction machine in response to fee authorization input to the machine, especially where a machine processor can cause an account to be charged responsive to network communication with a financial transaction computer. The Action does not factually support a *prima facie* conclusion of obviousness.

Claim 48

Claim 48 depends from claim 7. The references, taken alone or in combination, further do not teach or suggest delivering digital content through a cash-dispensing automated transaction machine audiovisual output device, especially in response to fee authorization input to the machine. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 49

Claim 49 depends from claim 31. The references, taken alone or in combination, further do not teach or suggest the recited digital content delivery arrangement with a cash-dispensing automated transaction machine, especially with fee authorization, account charging, and network communication. The Office has not established a *prima facie* showing of obviousness.

Claim 50

Claim 50 depends from claim 7. The references, taken alone or in combination, further do not teach or suggest the recited digital content delivery arrangement with a cash-dispensing automated transaction machine. A *prima facie* case of obviousness has not been established.

Claim 51

Claim 51 depends from claim 46. The references, taken alone or in combination, further do not teach or suggest delivering audio output through the sound system of a cash-dispensing automated transaction machine located in an establishment, especially where an account of an establishment operator can be charged for the delivered audio output. The Office has not established a *prima facie* case of obviousness.

Claim 52

Claim 52 depends from claim 48. The references, taken alone or in combination, further do not teach or suggest delivering audiovisual output through a cash-dispensing automated transaction machine located in an establishment, especially where an account of an establishment operator can be charged for the delivered audiovisual output. The Office has not established a *prima facie* case of obviousness.

Claim 53

Claim 53 depends from claim 7. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine that can cause the delivery of digital content responsive to deposit of cash into the machine's currency acceptor. Where do the combined references teach or suggest an automated transaction machine that links the delivery of digital content to the deposit of cash? Again, a *prima facie* case of obviousness has not been established.

Claim 54

Claim 54 depends from claim 47. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine that can cause the delivery of audiovisual outputs responsive to deposit of cash into the machine's currency acceptor. Where do the combined references teach or suggest an automated transaction machine that links the delivery of audiovisual outputs to the deposit of cash? The Office has not established a *prima facie* case of obviousness.

Claim 55

Claim 55 recites the steps of providing at least one account identifying input to the at least one input device of the automated transaction machine of claim 7; providing at least one dispense input to the at least one input device of the machine; and dispensing either cash from the machine or digital content responsive to the at least one dispense input.

As previously discussed, the combined references do not teach or suggest the at least one input device of the cash-dispensing automated transaction machine of claim 7. Note Appellants' remarks in support of the patentability of claim 7. Nor do the combined references teach or suggest providing account identifying input to an automated transaction machine, and dispensing either cash from the machine or digital content responsive to a dispense input. Where do the references teach or suggest the ability to dispense either cash or digital content in response to providing dispense input to a cash-dispensing automated transaction machine? Where do the references link providing dispense input to a cash-dispensing automated transaction machine to dispensing either cash or digital content?

The references, taken alone or in combination, do not teach or suggest the recited features, relationships, and steps. One having ordinary skill in the art would not have found it obvious to have modified De Leo in view of Monteiro and Duliege as alleged to have produced the recited method of claim 55.

Claim 56

Claim 56 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest charging an amount for the dispense of cash or digital content to an account associated with account identifying input. Where do the references teach or suggest

charging an amount in the manner recited? The Office has not established a *prima facie* case of obviousness.

Claim 57

Claim 57 depends from claim 56. The references, taken alone or in combination, further do not teach or suggest providing account identifying input to an automated transaction machine by reading account identifying indicia from a card, dispensing either cash from the machine or digital content responsive to a dispense input, and charging an amount for the dispense to an account associated with the account identifying input by communicating with a financial transaction computer remotely located from the machine. The Action does not factually support a *prima facie* conclusion of obviousness.

Claim 58

Claim 58 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest providing account identifying input to an automated transaction machine, and dispensing either cash from the machine or digital content responsive to a dispense input to the machine, and where dispensed digital content is recorded with a portable computing device. Again, a *prima facie* case of obviousness has not been established.

Claim 59

Claim 59 depends from claim 58. The references, taken alone or in combination, further do not teach or suggest the ability to record dispensed digital content with a portable computing device placed in releasible operative connection with a cash-dispensing automated transaction machine. The Office has not established a *prima facie* case of obviousness.

Claim 60

Claim 60 depends from claim 58. The references, taken alone or in combination, further do not teach or suggest the ability to dispense digital content responsive to dispense input to a cash-dispensing automated transaction machine, nor the ability to record the dispensed digital content with a portable computing device such that reproduction from the portable computing device is restricted. The Office has not established a *prima facie* case of obviousness.

Claim 61

Claim 61 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest the ability to dispense a sound file responsive to input provided to an input device of a cash-dispensing automated transaction machine. Where do the combined references link the providing of input to a cash-dispensing automated transaction machine input device to the dispensing of a sound file? A *prima facie* case of obviousness has not been established.

Claim 62

Claim 62 depends from claim 61. The references, taken alone or in combination, further do not link the providing of input to a cash-dispensing automated transaction machine input device to the dispensing of a music file. A *prima facie* case of obviousness has not been established.

Claim 63

Claim 63 depends from claim 61. The references, taken alone or in combination, further do not link the providing of input to a cash-dispensing automated transaction machine input

device to the dispensing of a digital document file. A *prima facie* case of obviousness has not been established.

Claim 64

Claim 64 depends from claim 61. The references, taken alone or in combination, further do not link the providing of input to a cash-dispensing automated transaction machine input device to the dispensing of a digital image file. A *prima facie* case of obviousness has not been established.

Claim 65

Claim 65 depends from claim 55. The references, taken alone or in combination, further do not link the providing of input to a cash-dispensing automated transaction machine input device to the dispensing of an audiovisual file. A *prima facie* case of obviousness has not been established.

Claim 66

Claim 66 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest that the dispensing of digital content comprises sending the digital content through at least one network to a network delivery address in the manner recited.

Claim 67

Claim 67 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest crediting an account associated with a source of the digital content responsive to dispense of the digital content. Where do the references teach or suggest crediting a digital content source account for digital content? The Action does not factually support a *prima facie* conclusion of obviousness.

Claim 68

Claim 68 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest crediting a licensing account associated with a licensing entity of the digital content responsive to the dispense of digital content. Where do the references teach or suggest crediting a licensing account for digital content? Again, the Office has not established a *prima facie* case of obviousness.

Claim 69

Claim 69 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest debiting an amount from an account associated with account identifying input; crediting the amount to a prepay account; and debiting the prepay account responsive to a digital content dispense. Where do the references teach or suggest a prepay account? Where do the references teach or suggest the recited relationships of crediting and debiting with regard to an account associated with identifying input and a prepay account? One having ordinary skill in the art would not have found it obvious to have modified De Leo in view of Monteiro and Duliege as alleged to have produced the recited method of claim 69.

Claim 70

Claim 70 depends from claim 55. The references, taken alone or in combination, further do not link the providing of input to a cash-dispensing automated transaction machine input device to the delivering of sounds through a sound system. The Office has not established a *prima facie* case of obviousness.

Claim 71

Claim 71 depends from claim 55. The references, taken alone or in combination, further do not link the providing of input to a cash-dispensing automated transaction machine input device to the delivering of audiovisual material through an audiovisual system. The Office has not established a *prima facie* case of obviousness.

Claim 72

Claim 72 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest the recited digital content dispensing method relating the providing of input to a cash-dispensing automated transaction machine input device to the dispensing of digital content. Again, a *prima facie* case of obviousness has not been established.

Claim 73

Claim 73 depends from claim 70. The references, taken alone or in combination, further do not teach or suggest charging an account associated with an establishment responsive to delivering sounds through a sound system, which delivering is responsive to input provided to an input device of a cash-dispensing automated transaction machine located in the establishment. The Office has not established a *prima facie* case of obviousness.

Claim 74

Claim 74 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest reproducing in a local content data store in a cash-dispensing automated transaction machine, digital content from a remote content data store accessed through at least one network by the machine. Nor has the Office established a *prima facie* showing of obviousness.

Claim 75

Claim 75 depends from claim 74. The references, taken alone or in combination, further do not teach or suggest delivering reproduced digital content from a local content data store in a cash-dispensing automated transaction machine. A *prima facie* showing of obviousness has not been established.

Claim 76

Claim 76 depends from claim 74. The references, taken alone or in combination, further do not teach or suggest delivering digital content from either a local content data store in a cash-dispensing automated transaction machine or a remote content data store, responsive to input provided to an input device of the machine. Again, the Office has not established a *prima facie* case of obviousness.

Claim 77

Claim 77 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest both providing account identifying input (comprising biometric input from a user of the machine) to an automated transaction machine and providing dispense input to the machine to cause dispensing. The Office has not established a *prima facie* showing of obviousness.

Claim 78

Claim 78 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest reproducing digital content on a portable media responsive to providing input to a cash-dispensing automated transaction machine input device. Again, a *prima facie* case of obviousness has not been established.

Claim 79

Claim 79 depends from claim 78. The references, taken alone or in combination, further do not teach or suggest reproducing digital content on a portable media (from a supply of portable media in an automated transaction machine) responsive to providing input to an input device of the machine. Nor has the Office established a *prima facie* showing of obviousness.

Claim 80

Claim 80 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest dispensing digital content to user-supplied portable media responsive to providing input to an automated transaction machine input device. The Office has not established a *prima facie* showing of obviousness.

Claim 81

Claim 81 depends from claim 55. The references, taken alone or in combination, further do not teach or suggest dispensing digital content responsive to the receipt of currency with a currency acceptor of an automated transaction machine. Again, a *prima facie* case of obviousness has not been established.

Claim 82

Note Appellants' remarks in support of the patentability of claims 7 and 55. None of De Leo or Monteiro or Duliege, taken alone or in combination, teach or suggest the recited computer readable media. For example, none of the references, taken alone or in combination, teach or suggest computer readable media that can cause a cash-dispensing automated transaction machine to carry out the dispensing of either cash from the machine or digital content, responsive to at least one account identifying input to an input device of the machine and at least one

dispense input to an input device of the machine. Where do the references teach or suggest computer readable media that can cause a cash-dispensing automated transaction machine processor to carry out such dispensing? The references do not teach or suggest the recited automated transaction machine computer readable media.

The Office has not established a *prima facie* showing of obviousness. Even if it were somehow possible to have De Leo and Monteiro and Duliege combined as alleged, the result still would not have produced the recited invention. Thus, it would not have been obvious to one having ordinary skill in the art to have modified De Leo with the teaching of Monteiro and Duliege to have produced the recited computer readable media of claim 82.

Claim 83

Claim 83 depends from claim 1. As previously discussed, the references, taken alone or in combination, do not teach or suggest a cash-dispensing automated transaction machine apparatus that provides a user thereof the ability to cause a currency dispense responsive to a first input and cause a digital information file dispense responsive to a second input, especially where the second input "corresponds" to the digital information file. Nor do the references, taken alone or in combination, further teach or suggest a computer processor of an automated transaction machine apparatus that can cause a charge of at least one fee associated with a digital information file dispense (claim 83). Where do the references teach or suggest an automated transaction machine apparatus that can cause the dispense of currency, can cause the dispense of a digital information file, and can charge a fee for the digital information file dispense? The Office has not established a *prima facie* showing of obviousness.

Claim 84

Claim 84 depends from claim 7. As previously discussed, the references, taken alone or in combination, do not teach or suggest an automated transaction machine that includes both a cash dispenser that can deliver cash responsive to input to an input device of the machine and an output device that can cause the delivery of digital content responsive to input of a digital content delivery fee authorization to an input device of the machine. That is, the references do not teach or suggest a cash-dispensing automated transaction machine having an input device that can receive fee authorization for delivery of digital content, and an output device that can cause the delivery of the digital content responsive to the authorization. The references, taken alone or in combination, further do not teach or suggest that the cash-dispensing automated transaction machine can cause a charge of at least one fee associated with the delivery of digital content (claim 84). The Office has not established a *prima facie* showing of obviousness.

Claim 85

Note Appellants' remarks in support of the patentability of claims 1 and 7. None of De Leo or Monteiro or Duliege, taken alone or in combination, disclose or suggest the recited features and relationships. For example, none of the references, taken alone or in combination, disclose or suggest an automated transaction machine with the structural ability to receive currency dispense input, digital file selection input, digital file payment input, where the machine also includes both a currency dispenser device that can dispense currency responsive to user input and a file dispenser device that can cause the dispense of a selected digital file responsive to user input. Additional recited features and relationships not taught or suggested in the combined references have been previously discussed.

The combined references do not teach or suggest a currency-dispensing automated transaction machine with the ability to receive user selection for a digital file (that is selectable to plural machine users), receive user payment for the selected digital file, and dispense the selected digital file. The Office has not established a *prima facie* showing of obviousness. None of De Leo or Monteiro or Duliege, taken alone or in combination, disclose or suggest the recited apparatus. For reasons previously discussed, the Action is devoid of any teaching, suggestion, or motivation for combining the references to produce the recited apparatus. It would not have been obvious to one having ordinary skill in the art to have modified De Leo with the teaching of Monteiro and Duliege as alleged to have produced the recited apparatus of claim 85.

Claim 86

Note Appellants' remarks in support of the patentability of claim 85. None of De Leo or Monteiro or Duliege, taken alone or in combination, disclose or suggest the recited features, relationships, and steps. For example, none of the references, taken alone or in combination, disclose or suggest receiving machine user selection for a digital file at a currency-dispensing automated transaction machine, receiving machine user payment input for the selected digital file with the machine, and dispensing the selected digital file to the machine user. Additional recited features and relationships not taught or suggested in the combined references have been previously discussed.

The Office has not established a *prima facie* showing of obviousness. None of De Leo or Monteiro or Duliege, taken alone or in combination, disclose or suggest the recited method. For reasons previously discussed, the Action is devoid of any teaching, suggestion, or motivation for combining the references to produce the recited method. It would not have been obvious to one

having ordinary skill in the art to have modified De Leo with the teaching of Monteiro and Duliege as alleged to have produced the recited method of claim 86.

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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CLAIM APPENDIX

1. An automated transaction machine apparatus comprising:

at least one computer processor;

at least one data store in operative connection with the at least one computer processor, wherein the at least one computer processor is operative to cause a plurality of digital information files to be retrieved from at least one digital information source located remotely from the machine and saved in the data store;

at least one user input device in operative connection with the at least one computer processor, wherein the at least one user input device is operative to receive user input;

a cash dispenser device in operative connection with the at least one computer processor, wherein the at least one computer processor is operative to cause the cash dispenser to dispense currency responsive to at least one first user input through the at least one user input device; and

at least one output device in operative connection with the at least one computer processor, wherein the at least one computer processor is operative to cause the

dispense of at least one of the digital information files through the at least one output device responsive to at least one second user input through the at least one user input device that corresponds to the at least one digital information file, and wherein the at least one computer processor is operative to cause the dispense of the same digital information file to plural users.

2. The apparatus according to claim 1 wherein the at least one user input device comprises a card reader device in operative connection with the computer processor, wherein the card reader device is operative to read account indicia from a card, and wherein the computer processor is operative to cause one or more fees to be charged to the account corresponding to the dispense of currency and the dispense of the at least one digital information file.
3. The apparatus according to claim 1, wherein the at least one digital information file includes a digital sound recording file.
4. The apparatus according to claim 3, wherein the at least one digital information file includes an MP3 file.
5. The apparatus according to claim 3, wherein the at least one output device includes a sound system, and wherein the computer processor is operative to cause the output of sound through the sound system responsive to the at least one digital information file.

6. The apparatus according to claim 1, wherein the computer processor is operative to cause a licensing fee associated with the at least one digital information file, to be transferred to a licensing entity.

7. Apparatus comprising:

an automated transaction machine including:

at least one input device;

a cash dispenser, wherein the cash dispenser is operative to deliver cash from the machine responsive to at least one input to the at least one input device;

at least one output device, wherein the at least one output device is operative to cause the delivery of digital content responsive to at least one digital content delivery fee authorization input to the at least one input device, and wherein the at least one output device is operative to cause the delivery of the same digital content to different entities.

8. The apparatus according to claim 7 wherein the at least one output device is releasibly operatively connectable to a portable computing device.

9. The apparatus according to claim 8 wherein the at least one output device comprises a communications port releasibly operatively connectable to a portable computing device adjacent the machine.
10. The apparatus according to claim 9 wherein the digital content comprises at least one sound file.
11. The apparatus according to claim 10 wherein the at least one sound file comprises a music file.
12. The apparatus according to claim 9 wherein the digital content comprises at least one audiovisual file.
13. The apparatus according to claim 7 wherein the at least one input device is adapted to receive at least one input corresponding to an account, and wherein the machine further includes:

at least one processor, wherein the processor is in operative connection with the at least one input device, the cash dispenser and the at least one output device, and wherein the processor is operative to cause the account to be charged for at least one of delivered cash and digital content.

14. The apparatus according to claim 13 wherein the at least one input device includes a card reader, and wherein the input corresponding to an account is produced responsive to at least one card read by the card reader.
15. The apparatus according to claim 13 wherein the processor is operative to cause content indicia corresponding to a plurality of portions of the digital content to be output through the at least one output device, and wherein the processor is operative to cause a selected portion of the digital content to be delivered responsive to at least one selection input corresponding to the selected portion, through the at least one input device.
16. The apparatus according to claim 15 wherein the machine includes a display device and the content indicia is output through the display device.
17. The apparatus according to claim 16 wherein the content indicia includes a graphic image corresponding to at least one of the portions of the digital content.
18. The apparatus according to claim 13 wherein the apparatus comprises at least one content data store, wherein the digital content is delivered from the content data store.
19. The apparatus according to claim 18 wherein the content data store comprises a local content data store located in the machine.

20. The apparatus according to claim 18 and further comprising:

at least one network in operative connection with the machine; and

at least one remote computer in operative connection with the network, wherein the content data store is in the at least one remote computer.

21. The apparatus according to claim 20 and further comprising:

at least one financial transaction computer in operative connection with the at least one network, wherein the processor is operative to cause the account to be charged through communication with the at least one financial transaction computer through the at least one network.

22. The apparatus according to claim 18 wherein the at least one input device on the machine is operative to receive a network delivery address, and further comprising:

at least one network in operative connection with the machine, wherein the processor is operative to cause the digital content to be delivered through the at least one network to the network delivery address, whereby a remote computer corresponding to the network delivery address is enabled to receive the digital content.

23. The apparatus according to claim 19 and further comprising:
- at least one network in operative connection with the machine; and
- at least one remote computer in operative connection with the network, wherein the at least one remote computer includes at least one remote content data store.
24. The apparatus according to claim 23, wherein the machine is operative to selectively deliver digital content from either the local content data store or the remote content data store responsive to at least one input to the at least one input device.
25. The apparatus according to claim 23 wherein the processor is operative to cause digital content in the remote content data store to be stored in the local content data store.
26. The apparatus according to claim 25 wherein the processor is operative on a periodic basis to cause selected digital content in the remote content data store to be stored in the local data store.
27. The apparatus according to claim 26 wherein the selected digital content comprises at least one sound file corresponding to at least one currently popular song.

28. The apparatus according to claim 26 wherein the selected digital content comprises at least one sound file corresponding to at least one currently popular book.
29. The apparatus according to claim 26 wherein the selected digital content comprises at least one audiovisual file corresponding to at least one currently popular movie.
30. The apparatus according to claim 27 wherein the selected digital content includes at least one graphic image corresponding to the at least one song.
31. The apparatus according to claim 13 and further comprising:
- at least one network in operative connection with the machine,
- at least one financial transaction computer in operative connection with the network, wherein the processor is operative to cause the account to be charged responsive to communication through the at least one network with the at least one financial transaction computer.
32. The apparatus according to claim 31 wherein the at least one financial transaction computer includes a source account associated with a source of the digital content, and wherein the source account is credited responsive to delivery of the digital content.

33. The apparatus according to claim 31 wherein the at least one financial transaction computer includes a licensing account associated with a licensing entity for the digital content, and wherein the licensing account is credited responsive to the delivery of the digital content.
34. The apparatus according to claim 31 wherein the account is associated with a user of the machine, and wherein the at least one financial transaction computer includes the account, and wherein the account is debited responsive to either delivery of cash or delivery of digital content.
35. The apparatus according to claim 31 wherein the at least one financial transaction computer holds a content prepay account for delivery of digital content, and wherein the processor is operative responsive to at least one input to at least one input device to cause funds to be transferred from the account to the content prepay account, and wherein the processor is operative to cause the content prepay account to be debited responsive to the delivery of the digital content.
36. The apparatus according to claim 31 wherein the output device includes a reproduction device operative to reproduce the digital content on a portable storage medium.

37. The apparatus according to claim 36 wherein the reproduction device is operative to cause the digital content to be reproduced in a portable computing device releasibly operatively connectable with the machine.
38. The apparatus according to claim 37 wherein the digital content is reproduced in the portable computing device such that it can only be played in the portable computing device.
39. The apparatus according to claim 37 wherein the digital content is reproduced in the portable computing device such that it cannot be further transferred in digital form from the portable computing device.
40. The apparatus according to claim 37 wherein the digital content is reproduced in the portable computing device such that it can only be played a limited number of times.
41. The apparatus according to claim 37 wherein the digital content is reproduced in the portable computing device such that it can only be played during a limited time period.
42. The apparatus according to claim 36 wherein the machine includes a supply of portable media, and the reproduction device is operative to reproduce the digital content on the portable storage media from the supply.

43. The apparatus according to claim 8 wherein the digital content is reproduced in the portable computing device such that reproduction of the digital content is restricted.
44. The apparatus according to claim 7 wherein the machine further comprises a supply of portable storage media, and wherein the digital content is delivered by being reproduced on portable storage media from the supply.
45. The apparatus according to claim 31 wherein the at least one output device includes a sound system, and wherein the digital content is delivered through audio outputs through the sound system.
46. The apparatus according to claim 7 wherein the at least one output device includes a sound system, and wherein the digital content is delivered through audio outputs through the sound system.
47. The apparatus according to claim according to claim 31 wherein the at least one output device includes an audiovisual output device, and wherein the digital content is delivered as audiovisual outputs through the audiovisual output device.
48. The apparatus according to claim according to claim 7 wherein the at least one output device includes an audiovisual output device, and wherein the digital content is delivered as audiovisual outputs through the audiovisual output device.

49. The apparatus according to claim according to claim 31 wherein the at least one output device includes a printer device, and wherein the digital content is delivered by printing the digital content with the printer device.
50. The apparatus according to claim according to claim 7 wherein the at least one output device includes a printer device, and wherein the digital content is delivered by printing the digital content with the printer device.
51. The apparatus according to claim 46 wherein the machine is located in an establishment, and wherein the account charged for the delivered digital content is an account of an operator of the establishment.
52. The apparatus according to claim 48 wherein the machine is located in an establishment, and wherein the account charged for the delivered digital content is an account of an operator of the establishment.
53. The apparatus according to claim 7 wherein the automated transaction machine further comprises:

a currency acceptor, wherein the machine is further operative to deliver digital content responsive to deposit of cash into the currency acceptor.

54. The apparatus according to claim 47 wherein the automated transaction machine further comprises:

a currency acceptor, wherein the machine is further operative to deliver digital content responsive to deposit of cash into the currency acceptor.

55. A method comprising:

(a) providing at least one account identifying input to the at least one input device of the automated transaction machine of claim 7;

(b) providing at least one dispense input to the at least one input device of the machine;

(c) dispensing either cash from the machine or digital content responsive to the at least one dispense input.

56. The method according to claim 55 and further comprising:

(d) charging an amount for the dispense of cash or digital content, to an account associated with the at least one account identifying input.

57. The method according to claim 56 wherein step (a) comprises reading the account identifying indicia from a card with a card reader on the machine, and wherein step (d) comprises communicating with a financial transaction computer remotely located from the machine.
58. The method according to claim 55 wherein step (c) includes recording the dispensed digital content with a portable computing device.
59. The method according to claim 58 wherein step (c) includes placing the portable computing device in releasible operative connection with an output device on the machine.
60. The method according to claim 58 wherein in step (c) the recording is conducted such that reproduction from the portable computing device is restricted.
61. The method according to claim 55 wherein the digital content comprises a sound file.
62. The method according to claim 61 wherein the digital content comprises a music file.
63. The method according to claim 61 wherein the digital content comprises a document file.
64. The method according to claim 61 wherein the digital content comprises an image file.

65. The method according to claim 55 wherein the digital content comprises an audiovisual file.
66. The method according to claim 55 wherein in step (c) the dispense of digital content comprises sending the digital content through at least one network to a network delivery address.
67. The method according to claim 55 and further comprising:
- (d) crediting a source account associated with a source of the digital content responsive to the dispense of digital content in step (c).
68. The method according to claim 55 and further comprising:
- (d) crediting a licensing account associated with a licensing entity of the digital content responsive to the dispense of digital content in step (c).
69. The method according to claim 55 and further comprising:
- (d) debiting an amount from an account associated with the account identifying input; and

(e) crediting the amount to a prepay account;

(f) debiting the prepay account responsive to the dispense of digital content in step (c).

70. The method according to claim 55 wherein in step (c) the dispense of digital content includes delivering sounds through a sound system.

71. The method according to claim 55 wherein in step (c) the dispensing of digital content includes delivering audiovisual material through an audiovisual system.

72. The method according to claim 55 wherein in step (c) the dispense of digital content includes printing digital content with a printer.

73. The method according to claim 70 wherein the machine is located in an establishment, and further comprising:

(d) charging an account associated with the establishment responsive to the dispense of digital content.

74. The method according to claim 55 and further comprising:
- d) reproducing in a local content data store in the machine, digital content from at least one remote content data store accessed through at least one network by the machine.
75. The method according to claim 74 wherein in step (c) the digital content is delivered from the local content data store.
76. The method according to claim 74 wherein in step (c) the digital content is delivered from either the local content data store or the remote content data store.
77. The method according to claim 55 wherein in step (a) the account identifying input comprises a biometric input from a user of the machine.
78. The method according to claim 55 wherein step (c) comprises reproducing the digital content on a portable media.
79. The method according to claim 78 wherein in step (c) the portable media is from a supply of portable media in the machine.

80. The method according to claim 55 wherein in step (c) the portable media is supplied by a user of the machine.
81. The method according to claim 55 and further comprising:
- (d) receiving currency with a currency acceptor on the machine; and
 - (e) dispensing digital content responsive to the receipt of currency in step (d).
82. Computer readable media operative to cause at least one processor in the automated transaction machine to carry out step (c) recited in claim 55, responsive to performance of steps (a) and (b).
83. The apparatus according to claim 1 wherein the computer processor is operative to cause a charge of at least one fee associated with the dispense of at least one digital information file.
84. The apparatus according to claim 7 wherein the machine is operative to cause a charge of at least one fee associated with the delivery of digital content.

85. Apparatus comprising:

an automated transaction machine,

wherein the machine includes at least one input device,

wherein the at least one input device is operative to receive
machine user input corresponding to a currency dispense,

wherein the at least one input device is operative to receive
machine user input corresponding to selection of a digital file that
is selectable to plural machine users,

wherein the at least one input device is operative to receive
machine user input corresponding to a payment associated with
dispense of the selected digital file,

wherein the machine includes a currency dispenser device,

wherein the currency dispenser is operative to dispense currency,

wherein the machine includes a file dispenser device,

wherein the file dispenser device is operative to cause the dispense of the selected digital file responsive to at least one machine user input to the at least one input device.

86. A method comprising:

- (a) receiving, via at least one input device of an automated transaction machine having a currency dispenser operative to dispense currency, machine user input corresponding to selection of a digital file that is selectable to plural users of the machine;
- (b) receiving, via the at least one input device, machine user input corresponding to a payment associated with dispense of the selected digital file;
- (c) dispensing the selected digital file responsive to at least one machine user input to the at least one input device.